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IN THE

Supreme Court of the United States

October Term, 1946
Nos. 1273 and 1274

REFRIGERATION PATENTS CORPORATION,
Petitioner,

against

STEWART-WARNER CORPORATION,
Respondent.

POTTER REFRIGERATOR CORPORATION,
Petitioner,

against

STEWART-WARNER CORPORATION,
Respondent.

PETITIONERS' REPLY TO RESPONDENT'S BRIEF

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PETITIONERS' REPLY TO RESPONDENT'S BRIEF

I. Respondent's brief is not directed to the issue presented. Your petitioners each filed an action at law against respondent. The two cases were tried before the same jury. The instructions on the point here in question were submitted by respondent's attorneys. The charge called for general verdicts in each case. No exception was taken to that charge, no request was made for any different or further charge. The jury rendered general verdicts for petitioners.

It was for the jury to take the law as instructed by the court, apply it to the facts as they found them to be, and

express their conclusions in general verdicts that would embody the law and the facts. *Walker* v. *Southern Pacific Railroad,* 165 U. S. 593, 596.

On appeal, the court below overrode the jury verdicts, not on any pretense of any misdirection but solely on the assertion of a particular non-direction.

The question presented by the petition is whether an appellate court has the right to re-examine, other than according to the rules of the common law, an issue of fact concluded by the verdict of a jury. The petition shows that such re-examination was not in accordance with the rules of the common law, and so was in defiance of the Seventh Amendment to the Constitution.

This question is a matter of such serious general consequence that the Act of March 3, 1891, which created Circuit Courts of Appeals and made their determination final in suits arising under the patent laws, nevertheless by specific provision preserved the right of appeal "in cases involving the construction or application of the Constitution of the United States". *United States* v. *American Bell Telephone Co.,* 159 U. S. 548, 551. Until the Act of February 13, 1925, Judicial Code, Section 240, petitioners could have presented this claimed violation of the Constitution as a matter of right. It is not credible that Congress, passing these acts to relieve this Court of a burden of litigation "which operated to impede the disposition of cases of peculiar gravity and general importance" (*American Bell Telephone* case, *supra,* p. 554), supposed that any court of the United States would disregard the Constitution, or if any did, that this Court would not, as matter of course, speedily require the reformation of any such abuse.

II. Respondent's brief in opposition now seeks to distract attention from the question presented, by pretending that here is the usual non-jury patent suit where judges, not juries, determine all issues. It avoids the constitutional question by devoting a large part of its eighteen pages to argument that petitioners' patents ought never to have been found valid over the prior art. Such argument is utterly beside the point. The issues of validity and infringement were issues of fact for the jury's determination and the jury determined them. That determination must stand in a federal appellate court. *Tyler* v. *Boston*, 74 U. S. 327, 331.(1)

It is not within the province of an appellate court, not even this Court, to reverse a judgment merely because it is dissatisfied with the findings of a jury. *Herencia* v. *Guzman*, 219 U. S. 44, 45. In *Express Co.* v. *Ware*, 87 U. S. 543, 545, this Court summed up the law in this one sentence:

> "We see no error in the charge, and cannot examine the evidence to ascertain whether the jury was justified in finding as it did upon the issues of fact."

In *Aetna Life Ins. Co.* v. *Ward*, 140 U. S. 76, 91, this Court said:

> "It may be that if we were to usurp the functions of the jury and determine the weight to be given to the

(1) This Court has no more right than the Seventh Circuit Court of Appeals to pass on the validity of these patents. The reason for the third of the Questions Presented, page 6 of petition, was to afford this Court an opportunity to clarify its *Halliburton* decision for the reasons stated on pages 8, 9 of the petition.

> evidence, we might arrive at a different conclusion. But that is not our province on a writ of error."

The lower court has concluded that a particular instruction was missing from the trial judge's charge. But respondent got the precise instructions it asked for in respect of Rev. Stat. 4888, 35 U. S. C. §33. The respondent admits (p. 14) that, as stated in the petition (p. 5), "The instructions on this point were in the form submitted by respondent and it requested no different or additional instructions thereon. There was no objection or claim of misdirection or non-direction by respondent". Respondent claims that the appellate court below nevertheless had the right to notice "plain error". The assertion is a pure after-thought, not presented to the court below and not found by it. More importantly, no such error existed. *Mis*direction, or refusal to give requested proper direction, would be "plain error". Neither fault occurred in the trial judge's charge herein. All requested instructions were given, and the charge as a whole was characterized by the court below as an "admirable exposition of patent law". In such circumstances, there was no error, "plain" or otherwise.

Respondent cites *United Brotherhood of Carpenters and Joiners of America* v. *United States*, 91 L. Ed. (Adv. ops.) 705, 714, but that was a case of positive misdirection compounded by refusal of proper requested direction. The opinion states (91 L. Ed. at pp. 712, 713):

> "These requested instructions were refused and instead instructions were given that stated a different concept of law * * * A failure to charge correctly is not harmless since the verdict might have resulted

> from the incorrect instruction. * * * The error is aggravated by the failure to give the correct charge upon request."

Respondent also cites *Royal Insurance Company* v. *Miller,* 199 U. S. 353, 369, and quotes:

> "As we are at liberty, however, despite the absence of an assignment of error on the subject, to consider a plain error arising on the record, we have given our attention to the subjects referred to * * *."

The remainder of the sentence reads:

> "and content ourselves with saying that we think they are devoid of merit."

The case is without pertinency.

Respondent also cites *Blanos* v. *Kulesva,* 107 Conn. 476, where the state court trial judge read to the jury a motor vehicle statute. Such reading, in the opinion of the majority of the appellate court was insufficient. The case is without any relevancy herein where only federal law can be regarded. *Sola Electric Co.* v. *Jefferson Co.,* 317 U. S. 173, 176.

If any state law could be applied it would be the law of Illinois since respondent is an Illinois corporation and these actions at law were brought in Illinois where respondent was making and selling what the jury found to be infringement. Such law is succinctly stated in *Provident Hospital* v. *Barbour,* 58 Ill. App. 421, 422:

> "It has never, in this State, been held error not to instruct, when not asked."

See also *Drury* v. *Connell*, 177 Ill. 43, 44; *Malott* v. *Hood*, 201 Ill. 202, 205; *Osgood* v. *Skinner*, 211 Ill. 229, 240; *Central etc.* v. *Ankiewicz*, 213 Ill. 631, 632; *People* v. *Lucas*, 244 Ill. 603, 614-615; *Wilkinson* v. *Service*, 249 Ill. 146, 152.

Similarly this Court said in *Mutual Life Ins. Co.* v. *Snyder*, 93 U. S. 393, 394:

> "But the omission of the learned judge to instruct the jury on a particular aspect of the case, however material, cannot be assigned for error, unless his attention was called to it with a request to instruct upon it."

There have been a great many similar pronouncements by this Court including the four cases cited on pages 19, 20, of petitioners' brief.

In one of those cases, the famous patent case, *Pennock* v. *Dialogue*, 27 U. S. 1, precisely the same argument as that now advanced by the respondent in our case was made by counsel in that case as follows (27 U. S. 1, 5, 6):

> "As the case is presented on the bill of exceptions, the court, in their charge, undertook to state the whole law of the subject-matter to the jury; and the omission to instruct them on any one point is error. If in this charge of the court anything is omitted which was matter of law for the jury, it is misdirection."

This Court's rejection of that argument is quoted on pages 19, 20 of petitioners' brief.

III. The balance of respondent's brief, under a pretense of supplying "background", is an argumentative statement, purporting to be factual, of defensive propositions which it tried—unsuccessfully—to maintain before the jury. We shall discuss this briefly, not because validity of the patents

is before this Court, but to show the need for clarification of the *Halliburton* decision.

The term "non-frosting coil" means a coil on the external surface of which moisture from the air does not freeze and accumulate. In other words, the coil temperature is kept on the upper side of 32° F. (the freezing point of water). When respondent says:

> "Non-frosting merely defines a condition or state or 'what it will do' when and only when operated in some special manner which neither the specification nor the claims explains." (Respondent's Brief, p. 12)

it is endeavoring to impute a peculiarity or abstruseness which is the veriest nonsense. The only "special" operation is that the surface temperature shall not be maintained below the freezing point of water. Nothing could be more explicit and particular in this respect than the corresponding phrases in claims 12, 14, 16 and in claim 18, which are:

> "means constructed and arranged to maintain the external surface temperature of the expander in the warmer chamber above the said freezing point"

and

> "means constructed and arranged to maintain the humidity in the warmer chamber at a relative value of at least 100 per cent at 32 degrees Fahrenheit." (Respondent's Brief, p. 8)

As any tyro knows, there are dozens of usable refrigerants, and the expansion valve setting is naturally adjusted appropriately to the one selected to obtain any internal coil temperature desired. The difference between the inside coil temperature and the outside coil temperature is naturally affected by the rate of heat flow from the latter

to the former. This, as every tyro also knows, is affected by the relative surface areas and the material of the coil wall. All these factors are within the most rudimentary knowledge of the merest apprentice in the art. It is preposterous to think that a patent specification and claim which call for a coil surface temperature above 32° F. nevertheless lack the particularity required by statute unless accompanied by the narrowing and utterly immaterial limitations such as dimensions, shape and material of the coil, physical constants of refrigerant, and expansion pressure in pounds or millimeters of mercury, which may have been fortuitously chosen by the patentee for one machine. Specifications and claims so limited would not even have the virtue of additional disclosure to aid "any person skilled in the art or science to which it appertains * * * to make * * * and use the same"; but on the contrary would tend to hinder such purpose by diverting attention to trivialities. Finally, a patent having claims with such limitations would be so narrow in scope as not to be worth the paper it was written on.

Similarly, respondent's pretense that claims 10 and 11 are defective in reciting

> "the thermal insulation of the compartments being relatively so proportioned as to admit a greater inflow of heat into the cooling compartment than into freezing compartment." (Respondent's brief, p. 9).

is sheer nonsense. Every tyro knows that the rate of heat flow through insulation is affected by

> "(1) difference in thickness, (2) difference in character, (3) difference in temperatures maintained in the two compartments, and (4) difference in temperature between the compartments and the outside atmosphere." (id.)

No part of the new concept, the new "invention" of Bronaugh & Potter resided in such details. The contribution of the patentees to the art was in providing a new unitary household refrigerator all the elements of which, separately or in other associations, were familiar and well understood to the art; *but which the patentees were first cooperatively to associate in a new combination.* The claims here are drawn to the new combination of *essential* elements, and the omission therefrom of irrelevant trivialities is a virtue not a vice.

Neither the *coil,* nor any other single *element* which entered into the patentees' new combination, constitutes the "exact point of novelty". All of the novelty of their invention was in their *combination* of old elements which never before had been similarly combined.

Respondent's brief (pp. 13-16) seizes on a reference in the opinion below (R. IV, 2780) to "the issue of clarity of phraseology", but the statute (35 U. S. C. §33) uses the words "such full, clear, concise and exact terms" with reference to sufficiency of patent *disclosure* "to enable anyone skilled in the art * * * to make * * * and use the same". Compliance in that respect, as found by the jury, was not disturbed by the court below. Where the statute deals with the patent *claims, i.e.,* the subject matter protected, it uses the words "shall particularly point out and distinctly claim the part, improvement or combination which he claims as his invention". It was on this latter point that the court below reversed the verdicts because (it said) the jury had been given "no instruction on the matter". Actually the jury had been admirably instructed on the exact matter in the language quoted in the petition (pp. 15, 16), which respondent now ignores so assiduously.

If the *Halliburton* decision was intended to be limited to cases where patentable novelty inhered in improving *one element only* of a combination, then that doctrine has no proper application to the case at bar. Unfortunately, the *Halliburton* decision has not been generally so interpreted or applied, and it is that conflict and confusion which was referred to in the petition as a further reason for its grant. Since the petition was filed, there has been reported the decision of the Circuit Court of Appeals for the First Circuit in *Leeds & Northrup Co.* v. *Doble Engineering Co.*, 73 USPQ 199. There the opinion says:

> "In the Halliburton case the Supreme Court was considering combination claims, and in doing so held that each element of a claimed combination must be described in terms of that element's physical characteristics or arrangement in the new combination apparatus, not in terms of what that element will do, i.e., in functional language, so that as a result after-discovered devices beyond the range of equivalents which might be used to accomplish the purpose served by an element of the patented combination will not be included in the monopoly of the patent."

This is another example of the need for correction and clarification referred to in petitioners' main brief, pp. 21-25.

The writs prayed for should be granted.

Respectfully submitted,

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